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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,690	06/22/2000	Thomas J. Perkowski	100-035USA000	7979

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Thomas J Perkowski Esquire PC
Soundview Plaza
1266 East Main Street
Stamford, CT 06902

EXAMINER	
BROWN, TIMOTHY M	

ART UNIT	PAPER NUMBER
1648	

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/599,690	PERKOWSKI, THOMAS J.	
	Examiner	Art Unit	
	Tim Brown	1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 August 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 10, 2004 has been entered. Claims 1-12 have been canceled. Claims 13-16 are under examination.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13-16 are rejected under the judicially created doctrine of double patenting over claim 2 of U.S. Patent No. 6,625,581 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows. The patent and the application both distribute consumer using a system having a first and second Internet-based information server, an Internet-enabled database, and an Internet enabled database server. In particular, the patent and the application feature a CPIR-enabled servlet tag which automatically executes upon being selected by a user. Therefore, the application claims read on the invention claimed in the patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13-16 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. The invention is drawn to an "Internet-based consumer product brand information management and communication system for use within the enterprise of a manufacturer." However, the claimed system is not operative for brand information management. Rather, the system processes requests from a consumer (see claim 13, lines 27 and 39), and responds by serving the consumer with a

plurality of product URLs. There is no mention of the system being configured to permit information management by a manufacturer. Accordingly, the invention is inoperative for failing to provide the claimed utility.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13-16 are rejected rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant's invention is a system for conducting brand management. However, the system is not configured to allow a system manager to access and alter product data. The specification is silent on how brand management can be accomplished without having control over product data. Therefore, the specification fails to enable the invention of claims 13-16.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preamble of claims 13-16 state the invention is

"[a]n Internet-based consumer product brand information management and communication system for use within the enterprise of a manufacturer." As noted above, the invention does not perform the claimed function. Applicant's system does however display a plurality of URLs to a consumer. Claims 13-16 are therefore drawn to a system for conducting brand management, yet function to provide a consumer with product URLs. Therefore, the it is unclear whether the invention is drawn to a system for brand management, or a system for providing consumer information. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz et al. (5,978,773) ("Hudetz") in view of Gosling et al. (US 6,247,044) ("Gosling").

Hudetz teaches an Internet-based product information management system comprising:

a central relational database management system for storing and managing UPN, trademark, product data and URL information as claimed, wherein the database management system maintains a data link record for a plurality of registered producs (col. 7, lines 10-14; and Fig. 1, chars. 22 and 60);

a first Internet-based information server (col. 5, lines 47-65; and Fig. 1, chars. 24 and 26);

a first Internet-enabled database server (Id.);

an Internet-enabled client computer (col. 5, lnes 13-18; and Fig. 2, char. 28);

a Web-based client computer for use by a brand management team member (col. 5, lines 13-17).

Hudetz does not expressly teach a second Internet-enabled information server for storing a servlet, nor a third Internet-enabled information server for serving the servlet. However, Gosling teaches this feature in that it discloses a remote server storing at least one servlet, and the at least one servlet to a local server computer (col. 3, lines 37-43). Gosling states the benefit of a servlet is that it can provide dynamically generated information, and enhanced security. Therefore, at the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Hudetz to include a servlet as taught by Gosling to provide real-time information and enhanced security. Note that Hudetz suggests providing secure database access at column 9, lines 43 through 53.

Hudetz does not expressly teach providing a servlet tag within a consumer product image. However, using images to represent data links was well within the knowledge generally available to the skilled artisan at the time of Applicants' invention. It was also within the knowledge generally available to the skilled artisan that using image hyperlink provided a means for browsing large amounts of content quickly. Therefore, at the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify the asserted combination with an image hyperlink in order to provide enhanced content presentation and ease of navigation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Brown whose telephone number is (571) 272-0773. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on (571) 272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tim Brown
Examiner
Art Unit 1648

tb

Jeffrey A. Smith
Primary Examiner